

REMARKS

The Specification has been amended to correct the recitation in the first paragraph to claim priority under 35 USC 120.

Claims 1, 2 and 57 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-114 are now pending in this application.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 2, and 57 have been amended. Claim 1 has been amended to clarify that the buyer entity does not enter into a binding commitment to purchase the product or service from a specific selling entity. Claim 2 has been amended to further distinguish this claim over Walker, although we contend that such distinction is unnecessary as explained above (and our amendment or remarks regarding the distinction of the present invention relative to Walker should not be read to imply otherwise.)

Various claims were rejected under 35 USC 102 as anticipated by Walker et al. application (20040039639). The rejection of the claims is traversed and reconsideration is respectfully requested.

The Walker et al. (20040039639) application filed on August 18, 2003 claims priority to a continuation of application serial no. 09/349,860 that has a filing date of July 9, 1999. The chain to this earlier application was broken due to a failure to file a Petition for an Extension of Time in the 09/349,860 application, so that the (20040039639) application filed

on August 18, 2003 was not entitled to the priority of serial no. 09/349,860. The requirement that was violated for the then-pending parent application is a statutory requirement that cannot be waived.

It is noted from PAIR that an Abandonment for Failure to Respond to Office Action was mailed to Applicant on November 17, 2003. After more than a two year delay, a Petition to Revive based on the relaxed standard of unintentional delay for 09/349,860 was entered on December 9, 2005. The Petition to Revive was granted on December 29, 2005.

The alleged revival, if it is valid, is not retroactive for patent-defeating purposes. See *Urologix, Inc. v. Prostalund AB*, 256 F. Supp. 2d 911 (Dis. Ct E.D. Wis. 2003), copy attached. The alleged revival, if valid, is not patent-defeating for the application of another applicant that was pending during the abandoned period, particularly for a revival based on unintentional delay. Such revival only fixes the chain of priority for purposes of maintaining the validity of the Walker application against prior art in this period. There is no patent-defeating retroactivity provided by the statute which authorizes revival for failure to respond to an office action based on unintentional delay. 35 USC 41 (a)(7)

(7) On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110.

Compare 35 USC 41 (c)(1) and (2) relating to revival for late payment of maintenance fees up to 24 months after the six-month grace period has lapsed. Congress intended a retroactive effect for this revival under Section 41 by stating in the statute “the patent shall be considered as not having expired at the end of the grace period,” and explicitly provided for intervening rights. See 35 USC 41(c)(2). No such language authorizing intervening rights is

found for petitions to revive a pending application for failure to respond within the statutory time period based on relaxed “unintentional delay.”

Additionally, a two year delay after the Notice of Abandonment for Failure to Respond to Office Action was mailed to Applicant on November 17, 2003 cannot be considered either unintentional or unavoidable.

Since the present Landesmann application is entitled to a priority date of October 30, 2000, reconsideration and withdrawal of this rejection is respectfully requested. Note that during the period when there was a break in the chain of priority, the Walker (20040039639) application is not prior art to the present application, which was filed shortly after the Walker parent 1999 filing date and it cannot be converted to patent-defeating prior art retroactively. Accordingly, the Walker publication is not patent-defeating prior art relative to the present application.

Claims 16 and 73 were rejected under 35 USC 112, second paragraph, as being indefinite, because the words “benefit” and “reward” appear to be synonyms. The dictionary definition of the word “benefit” is “something that promotes well-being”, while “reward” is defined as “a recompense for at least one worthy act.” Thus, a set of benefits could comprise benefits that are not rewards, i.e., are not provided in recompense for an act, such as better pre-sales service. But a reward is a subset of “benefits.” A “reward” could be the offering of compensation for viewing (an act) an advertisement. See for instance, the following sentence in paragraph 92 of the specification: “Accordingly, it is in the interest of advertisers to convey particularly attractive benefits, such as pre-sale services [a benefit but not a reward] and lucrative pay to view advertisements [both a benefit and a reward] to such a buyer entity.” (Comments in brackets added.)

Although Walker is not prior art applicable to the present application, the following points are made with respect to Walker. Walker does not disclose the making of deposits, or the cancellation thereof. Walker procures intent data and cites the forecasting of demand as an objective in this regard. The purpose of obtaining purchase intent data of the present system is not to forecast demand, but to change it, in part, by trying to influence and steer the

purchase intent of the buyer entity towards a particular brand or manufacturer or supplier. Walker does not disclose the negative restriction that the buyer entity does not disclose a commitment to purchase from a particular seller. In the present invention, it is important that the buyer entity has not made a commitment and final decision regarding a particular supplier, because that would defeat its main purpose. The Walker system offers rewards, but these rewards are not for viewing advertisements or otherwise informing the buyer entity regarding the merits of a particular brand or item. The rewards offered by the Walker system are purely meant to recompense the buyer entity for the provision of the purchase intent information, and the purpose of the penalty in Walker is to retroactively cancel or compensate for that reward, in the event that the purchase intent information is not substantiated by a later proof of purchase.

By contrast, in the present system, the buyer entity, in one embodiment, willingly accepts the risk of a penalty or material loss to prove to merchants that he or she is serious about purchasing a particular product, and to distinguish him- or herself from window shoppers that might receive less attention from suppliers. Walker discloses the offering of coupons or discounts by merchants which lower the price of their products, but the consumer window of intent is not used in Walker to reward the buyer entity for the act of exposing itself to information that is favorable to a specific purchase. The amendments to claim 2 are meant to more clearly point out this distinction.

Claim 57 (and parallel claims) has been amended to specify that the language in this claim is (and has been) intended to cover a continuing purchase commitment, not a single purchase as disclosed in Walker. The reference cited by Examiner in this regard does not disclose or anticipate the present claim 57 limitation. Having a single penalty commitment for multiple purchases over a specified period of time is far more effective (and has far lower transaction costs) than entering into multiple successive arrangements for each of these purchases separately.

Claim 56 (and parallel claims) is directed towards buyer entities additionally proving by submission of past purchase records that they are likely buyers of the serious intent good

or service in the future. It is not disclosed or anticipated by Walker. Examiner references paragraphs 37, 70 and 71, but these paragraphs do not comprise the claim 56 limitation(s).

All remarks are without prejudice to related applications, and nothing in this filing should be construed as an admission that the Walker US 2004/0039639 A1 application discloses any claimed elements unless stated otherwise.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date May 16, 2006

By  _____

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5485
Facsimile: (202) 672-5399

William T. Ellis
Attorney for Applicant
Registration No. 26,874

Westlaw.

256 F.Supp.2d 911
256 F.Supp.2d 911
(Cite as: 256 F.Supp.2d 911)



Page 1

H

Briefs and Other Related Documents

United States District Court, E.D. Wisconsin.
UROLOGIX, INC., Plaintiff,

v.

PROSTALUND AB, Prostalund Operations AB, and
Circon Corporation, a/k/a ACMI Corporation,
Defendants.
No. 02-C-0318.

April 7, 2003.

Owner of patent for surgical instrument, suing competitors for infringement, moved for reconsideration of order finding that patent was invalid, 227 F.Supp.2d 1033. The District Court, Adelman, J., held that reconsideration was not warranted.

Motion denied.

West Headnotes

[1] Courts 106 99(1)

106 Courts

106II Establishment, Organization, and Procedure
106II(G) Rules of Decision

106k99 Previous Decisions in Same Case as Law of the Case

106k99(1) k. In General. Most Cited

Cases

Although court may reconsider its interlocutory orders at any time before entry of judgment, law of case doctrine counsels court in general to not reopen issues once decided. Fed.Rules Civ.Proc.Rule 54(b), 28 U.S.C.A.

[2] Federal Civil Procedure 170A 928

170A Federal Civil Procedure

170AVII Pleadings and Motions

170AVII(I) Motions in General

170Ak928 k. Determination. Most Cited

Cases

Although court will reconsider order in exceptional circumstance where its prior decision is clearly erroneous and would work manifest injustice, parties are expected to marshal all their arguments and evidence in opposition to dispositive motions, and

court views belated factual or legal attacks with great suspicion. Fed.Rules Civ.Proc.Rule 54(b), 28 U.S.C.A.

[3] Patents 291 110

291 Patents

291IV Applications and Proceedings Thereon

291k110 k. Renewal of Application. Most Cited Cases

Patents 291 323.3

291 Patents

291XII Infringement

291XII(C) Suits in Equity

291k323 Final Judgment or Decree

291k323.3 k. Relief from Judgment or Decree. Most Cited Cases

Reconsideration of order finding patent invalid, on ground that application's lack of co-pendency deprived it of abandoned parent application's filing date, leaving it anticipated by prior art, was not warranted absent showing of clear error or manifest injustice; Patent and Trademark Office's subsequent revival of parent application was not retroactively effective, and patentee's failure to obtain earlier revival was intentional litigation strategy. Fed.Rules Civ.Proc.Rule 54(b), 28 U.S.C.A.; 35 U.S.C.A. § 41(a)(7), 102, 120.

Patents 291 328(2)

291 Patents

291XIII Decisions on the Validity, Construction, and Infringement of Particular Patents

291k328 Patents Enumerated

291k328(2) k. Original Utility. Most Cited Cases
5,234,004. Invalid.

*912 A. Sidney KATZ, Chicago, IL, James Volling, Minneapolis, MN, Robert Briesblatt, Chicago, IL, for Plaintiff.

Kathleen Donius, Milwaukee, WI, Doris Johnson Hines, Washington, DC, Willem Schuurman, Austin, TX, Christopher Banaszak, Milwaukee, WI, Stephen Hash, Austin, TX, for Defendants.

DECISION AND ORDER

256 F.Supp.2d 911
 256 F.Supp.2d 911
 (Cite as: 256 F.Supp.2d 911)

ADELMAN, District Judge.

On October 10, 2002, I granted defendants' motion for summary judgment and held that plaintiff Urologix's U.S. Patent No. 5,234,004 (the "'004 patent") is invalid under 35 U.S.C. § 102(d). Urologix, Inc. v. Prostalund AB, 227 F.Supp.2d 1033 (E.D.Wis.2002). Urologix has now filed a motion pursuant to Fed.R.Civ.P. 54(b) requesting that I vacate my prior order.^{FN1}

FN1. Both parties filed additional briefs with motions requesting that I consider them. I have done so and, therefore, will grant the parties' motions. (R. 150, 155.)

I. BACKGROUND

To explain my ruling on Urologix's motion to vacate, I must recount some of the history of the prosecution of the '004 patent. This history appears in more detail in my October 10, 2002 decision ("October 2002 decision").

In my October 2002 decision, I found the '004 patent invalid under 35 U.S.C. § 102(d) because the application that matured into the '004 patent, application serial No. 667,847 (the "'847 application"), and its parent application, serial No. 438,741 (the "'741 application"), were not copending. When the '741 application was filed, the applicants claimed a priority filing date under 35 U.S.C. § 120 based on an earlier-filed French application (the "French application"). On November 21, 1990, the United States Patent and Trademark Office ("PTO") issued an Office Action in the '741 application requiring a response from applicants within a three-month period. No response was filed; thus, the '741 application became abandoned.

After abandonment, the applicants filed the '847 application as a continuation-in-part of the '741 application. The '847 application also claimed a priority filing date under 35 U.S.C. § 120 based on the French application. However, because the '741 application was abandoned before the '847 application was filed, copendency between the '741 application and the '847 application did not exist. Hence, priority could not be claimed based on the French application.^{FN2} The French application, therefore, became invalidating prior art under section 102(d).

FN2. For an application to receive the benefit of an earlier effective filing date under 35 U.S.C. § 120, it must be "filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application" See 35 U.S.C. § 120.

This issue of copendency was raised in a prior action in this district when the '004 patent was owned by Technomed Medical Systems, Inc. ("Technomed"). See Technomed Med. Sys., Inc. v. Dornier Med. Sys., Inc., No. 98-C-345, slip op. at *2 *913 (E.D.Wis. Jul. 17, 1998) (Clevert, J.) (hereinafter, "*Technomed*"). Technomed was represented by the same attorneys who represent Urologix here. The defendant in that action, Dornier Medical Systems, Inc., argued, among other things, that the '004 patent was invalid due to a failure of copendency and presented evidence on this issue at a preliminary injunction hearing. The court did not decide the patent's validity, but did find in addressing Technomed's motion for a preliminary injunction, that Technomed had a reasonable likelihood of successfully defending against the invalidity charge. *Technomed*, slip op. at 6. Soon after, the case settled.

On March 29, 2002, Urologix filed the instant case against Prostalund AB, Prostalund Operations AB, and Circon Corporation, a/k/a ACMI Corporation (collectively, "Prostalund") for infringement of the '004 patent. As discussed above, Prostalund filed a summary judgment motion arguing invalidity due to a failure of copendency. Urologix argued in response that the '004 patent was valid and that, if it was not, I should allow Urologix to petition the PTO to revive the '741 application so as to fix the failure of copendency. In my October 2002 decision, I found that the patent was invalid and declined to put off my decision to permit Urologix to petition the PTO because I found that "Urologix ha[d] known about the copendency problem since at least 1998 when the issue was raised in [the *Technomed* litigation], yet taken no action to remedy it." Urologix, 227 F.Supp.2d at 1041.

After my October 2002 decision issued, Urologix filed a PTO petition to revive the '741 application under 37 C.F.R. § 1.137(b) for the specific purpose of correcting the failure of copendency. (R. 143 Ex. 1.) A patent-holder can petition the PTO to revive an abandoned application and, thereby, correct a failure of copendency. See 35 U.S.C. § 41(a)(7). However, under 37 C.F.R. § 1.137(b), the entire

period of delay "from the due date for the reply until the filing of a grantable petition" to revive must be "unintentional" and the petitioner's petition must include a statement to that effect. 37 C.F.R. § 1.137(b)(3). In evaluating these petitions, the PTO "relies upon the applicant's duty of candor and good faith and accepts the statement that 'the entire delay ... was unintentional' without requiring further information in the vast majority of petitions." Manual of Patent Examining Procedure ("MPEP") § 711.03(c)(III)(C) (8th ed.2001).

In its petition, Urologix argued to the PTO that "any abandonment of the '741 application before establishing copendency with the '847 application was unintentional, and therefore within the PTO's discretion to cure." (R. 143 Ex. 1.) In addition, contrary to my October 2002 decision, Urologix stated that "[i]t was not until receipt of the Courts' [sic] October 10, 2002 decision that the need to file this petition was noted." (*Id.*) In a footnote, Urologix mentioned the *Technomed* decision, but said that "[o]n the basis of th[e] decision, there was no need for the Applicants to take any action to address the alleged lack of copendency." (*Id.*) Hence, Urologix maintained before the PTO that the entire period of delay was unintentional because Urologix did not know of the copendency problem until October 2002. (*Id.*)

On November 19, 2002, the PTO granted Urologix's petition to revive. (R. 142 Ex. 2.) The PTO did not address the 1998 *Technomed* decision regarding the lack of copendency or my October 2002 decision, but only discussed the inadvertent failure in 1991 to maintain copendency during prosecution. Armed with this PTO decision, Urologix has returned to me to ask *914 that I vacate my October 2002 order finding the '004 patent invalid.

II. STANDARD FOR RECONSIDERATION

[1][2] The orderly administration of litigation requires that the finality of orders, even interlocutory ones, be reasonably certain. See *Gould, Inc. v. United States*, 67 F.3d 925, 930-31 (Fed.Cir.1995); *Mendenhall v. Barber-Greene Co.*, 26 F.3d 1573, 1582 (Fed.Cir.1994); *Rothner v. City of Chicago*, 929 F.2d 297, 301 (7th Cir.1991). Thus, although the court may reconsider its interlocutory orders at "any time before the entry of judgment," Fed.R.Civ.P. 54(b), under the law of the case doctrine, courts generally should not reopen issues once decided, *Agostini v. Felton*, 521 U.S. 203, 236,

117 S.Ct. 1997, 138 L.Ed.2d 391 (1997); *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 815, 108 S.Ct. 2166, 100 L.Ed.2d 811 (1988). ("[C]ourts should be loathe to [reconsider their prior decisions] in the absence of extraordinary circumstances."); *Creek v. Vill. of Westhaven*, 144 F.3d 441, 446 (7th Cir.1998). "The law of the case doctrine is not to be lightly disregarded. It is based on the salutary and sound public policy that litigation should come to an end." *Rothner*, 929 F.2d at 301. "An exception exists where the court is 'convinced that its prior decision is clearly erroneous and would work a manifest injustice.'" *Agostini*, 521 U.S. at 236, 117 S.Ct. 1997 (quoting *Arizona v. California*, 460 U.S. 605, 618, n. 8, 103 S.Ct. 1382, 75 L.Ed.2d 318 (1983)). However, parties are expected to marshal all their arguments and evidence in opposition to a dispositive motion. *Caisse Nationale de Credit Agricole v. CBI Indus., Inc.*, 90 F.3d 1264, 1270 (7th Cir.1996). The court will view "[b]elated factual or legal attacks ... with great suspicion." *Id.*^{FN3}

FN3. I apply the standard articulated by the Seventh Circuit because the standard is a matter of procedure not within the exclusive jurisdiction of the Federal Circuit. See *Genentech, Inc. v. Amgen, Inc.*, 289 F.3d 761, 768 (Fed.Cir.2002) ("On procedural issues not unique to this court's exclusive jurisdiction, this court applies the procedural law of the regional circuit."); *Serrano v. Telular*, 111 F.3d 1578, 1582, 1584-85 (Fed.Cir.1997) (applying law of regional circuit in reviewing a motion for reconsideration). However, I also cite Federal Circuit law, as the standards are substantially the same.

III. DISCUSSION

[3] As discussed, I ruled on ProstaLund's motion for summary judgment and found the '004 patent invalid due to a failure of copendency. This conclusion became the law of the case. Urologix now argues, however, that the later PTO decision corrected the failure of copendency and requires that I vacate my order. I therefore must determine whether the PTO decision makes my October 2002 clearly erroneous and manifestly unjust. I conclude that it does not.

A. Clearly Erroneous

Clear error is a high standard. The Seventh Circuit has explained that clear error "means more than just maybe or probably wrong; [the error] must ... strike [the court] as wrong with the force of a five-week-old, unrefrigerated dead fish." Parts & Elec. Motors, Inc. v. Sterling Elec., Inc., 866 F.2d 228, 233 (7th Cir.1988); accord Gindes v. United States, 740 F.2d 947, 950 (Fed.Cir.1984) ("[A] mere suspicion of error, no matter how well supported, does not warrant reopening an already decided point. Only if we were convinced to a certainty that our prior decision was incorrect would we be warranted in now reexamining it."). Urologix's arguments do not show that my decision meets this standard.

*915 Nothing Urologix has presented casts doubt on the correctness of my decision at the time it issued. The PTO decision does not show that my decision was erroneous at the time. To the contrary, the PTO decision indicates that I was correct in my conclusion that there was a failure to copendency and that, therefore, the '004 patent was invalid.

Rather, Urologix argues that the PTO decision makes my October 2002 decision clearly erroneous now. However, in order for that to be the case, the PTO's revival of the abandoned application must make the '004 patent retroactively valid, not only for purposes of future litigation, but for the purpose of this litigation initiated before the lapse was cured and in which the patent's invalidity has already been determined.

However, it is not clear that the PTO decision has any effect in ongoing litigation filed before the PTO issued its decision. A certificate of correction issued to remedy a failure of copendency, for example, has no effect in a lawsuit filed before the certificate issued. See, e.g., Southwest Software, Inc. v. Harlequin Inc., 226 F.3d 1280, 1294 (Fed.Cir.2000); see also Adrain v. Hypertech, Inc., No. 2:98-CV-37C, 2001 WL 740542, at *5 (D.Utah Apr. 18, 2001). I can find no case addressing the retroactive effect of revival pursuant to 35 U.S.C. § 41(a)(7), and the parties point to none. See Suntiger, Inc. v. Telebrands Adver., Inc., No. Civ.A.97-423-A, 1997 WL 855581, at *4 (E.D.Va. July 11, 1997) (declining to reach the issue). Indeed, Urologix appears to simply assume that the PTO decision to revive has retroactive effect in ongoing litigation. However, this conclusion is not at all apparent.

Furthermore, even if the PTO decision could effect ongoing litigation, it is not clear that such a decision could ever operate *nunc pro tunc* to undermine the

prior decision of a federal court. The Supreme Court has said that "[j]udgments, within the powers vested in courts by the Judiciary Article of the Constitution, may not lawfully be revised, overturned, or refused faith and credit by another Department of Government." Chi. & S. Air Lines, Inc. v. Waterman S.S. Corp., 333 U.S. 103, 113, 68 S.Ct. 431, 92 L.Ed. 568 (1948). To be sure, my October 2002 decision did not result in a judgment. Nonetheless, it conclusively resolved an issue that was within my power to resolve. Thus, it is not clear that the PTO decision could have any effect on my decision's validity.

In sum, Urologix has presented no argument that indicates that my October 2002 decision is clearly erroneous. However, even if I were to conclude otherwise, Urologix's motion would fail because I do not find that my decision works a manifest injustice.

B. Manifestly Unjust

Urologix's present circumstances are the result of the litigation strategy it chose; thus, my decision works no manifest injustice. As I previously determined, Urologix has known, since at least 1998 when the issue was raised in the *Technomed* litigation, that its patent may have failed to satisfy the copendency requirement of the patent statute. See 35 U.S.C. § 120. Although Judge Clevert held that Urologix had a reasonable likelihood of successfully defending against the invalidity charge, litigation of the issue put Urologix on notice that copendency might be a problem. After conclusion of the *Technomed* litigation in 1998, however, Urologix chose not to seek a ruling from the PTO regarding the copendency issue. The issue arose again in the present litigation when ProstaLund moved for summary judgment in May 2002. However, rather than asking the PTO to resolve the issue while the motion was pending, Urologix made a decision to *916 continue to defend the patent's validity. The parties engaged in discovery on the issue, prepared briefs and presented testimony. Then I decided the issue. Only when its strategy resulted in an unfavorable decision did Urologix petition the PTO to cure the problem. Urologix's much-belated attempt to resolve a problem it had known about for at least four years does not make my decision unjust. See Baumer v. United States, 685 F.2d 1318, 1321 (11th Cir.1982) (declining to revisit the law of the case where party's litigation strategy led to the challenged result); see also Caisse Nationale, 90 F.3d at 1270 (7th Cir.1996) (reaffirming that reconsideration "is not an

appropriate forum for ... arguing matters that could have been heard during the pendency of the previous motion"); *Smith Int'l, Inc. v. Hughes Tool Co.*, 759 F.2d 1572, 1578-79 (Fed.Cir.1985) (holding that district court acted properly in declining to consider evidence that could have been presented when issue was originally pending).

In addition, in persuading the PTO to revive the lapsed application, Urologix was less than fully candid. In its petition to the PTO, Urologix presented an incomplete picture of the circumstances surrounding the petition to revive. Urologix averred, as required for revival, that the entire period of delay, from the abandonment until the filing of the petition, was unintentional and that "until this Court issued its October 10[, 2002] Order, Urologix had every reason to believe that it had a *valid patent*." (R. 152 at 9.) In addition, to demonstrate to the PTO that the delay had been unintentional, Urologix relied on arguments that I had expressly rejected without indicating that I had done so. Urologix failed to mention that I had determined that it had been aware of the copendency issue since 1998, yet chose not to file a petition to revive. Moreover, merely attaching a copy of my decision containing statements contrary to those in the petition was insufficient because, under the MPEP, Urologix's statements to the PTO were presumed true. See MPEP § 711.03(c)(III)(C) (8th ed.2001); see also *id.* § 2001.06(c) (stating that an applicant for patent or reissue is under a duty to bring to the attention of the PTO "any assertion that is made during litigation which is contradictory to assertions made to the examiner.")). The PTO's revival of the application based on this incomplete picture of the record does not make my October 2002 decision manifestly unjust. Thus, the law of the case will stand.^{FN4}

^{FN4}. Urologix also has moved this court to vacate its October 16, 2002 Order denying Urologix's motion for preliminary injunction based on alleged infringement of the '004 patent. As I have not disturbed the October 10, 2002 order, I also do not disturb the October 16, 2002 order.

I note that the Federal Circuit in reviewing motions for reconsideration has also stated that revision is appropriate (1) where a change in the controlling law would now require that the court reach a different result and (2) where the moving party presents new evidence that could not have been presented during the original pendency of

the issue. See *Gould*, 67 F.3d at 930; *Smith Int'l*, 759 F.2d at 1578-79. Urologix has not demonstrated that either of these exceptions applies. First, the controlling law has not changed. Second, as discussed above, Urologix could have petitioned the PTO to correct the failure of copendency before I ruled on the motion for invalidity. Thus, the PTO decision does not constitute "new evidence" justifying reconsideration of my decision.

IV. CONCLUSION

THEREFORE, IT IS ORDERED that plaintiff's motion to vacate the court's decision and order dated October 10, 2002 is **DENIED**.

IT IS FURTHER ORDERED that plaintiff's motion to file a reply brief in support of its motion to vacate is **GRANTED***917 and that defendants' motion to file a surreply brief is **GRANTED**.

E.D.Wis.,2003.
Urologix, Inc. v. Prostalund AB
256 F.Supp.2d 911

Briefs and Other Related Documents ([Back to top](#))

• [2:02cv00318](#) (Docket) (Mar. 29, 2002)

END OF DOCUMENT